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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,484	09/15/2003	Wilhelm Kordes	2747-66937	2421

7590 07/06/2005

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EXAMINER

HAAS, WENDY C

ART UNIT

PAPER NUMBER

1661

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/663,484	KORDES, WILHELM	
Examiner	Art Unit		
Wendy C. Haas	1661		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

## Disposition of Claims

4)  Claim(s) 1 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 15 September 2003 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Prosecution Application***

The amendment filed 15 September 2003 requesting that the specification be amended to refer to the present Continued Prosecution Application (CPA) as a continuation application of Application No. 10/020,793 has not been entered. As set forth in 37 CFR 1.53(d)(7), a request for a CPA is the specific reference required by 35 U.S.C. 120 to every application assigned the application number identified in such request. Thus, there is no need to amend the first sentence(s) of the specification to refer back to the prior application and any such amendment shall be denied entry.

### ***Claim Rejections - 35 USC § 102***

Claim 1 remains rejected under 35 U.S.C. 102(b) as being anticipated by the German (DE) Plant Breeder's Right denomination, application and grant publications number ROS 01808 and in view of Applicant's admission (made in the parent application) that the instant plant was offered for sale sold more than one year prior to the filing date of the parent application this application claims priority to, at least as early as October of 1999.

The PBR denomination, application and grant are printed publications because they are accessible to the public. Under In re Elsner, 72 USPQ2d 1038, this type of printed publication is enabled by public availability of the claimed plant anywhere in the world more than one year prior to application for patent in the United States.

***Objection to the Disclosure***

**37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

*(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.*

**35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

*The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

*The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.*

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

*No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.*

The disclosure is objected to under 37 CFR 1.163 (a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More specifically:

- A. Page 1, applicant should specify that the claimed plant originated as a single plant from the stated cross. The claimed plant must originate as a single plant to qualify for statutory patent protection under 35 U.S.C. § 161 *et seq.*
- B. Page 2, lines 29 and 30, applicant should provide more information regarding the cultural conditions the claimed plant was grown under, such as temperature, ambient light levels, rainfall, fertilization and/or irrigation, etc. This information lends substantive meaning to the description of the plant, as claimed, as cultural conditions can affect the appearance of a plant.
- C. Page 3, line 2, applicant should provide the typical and observed bud diameter for the flower buds of the claimed plant.
- D. Page 3, line 27, applicant should provide the typical and observed peduncle diameter in order to provide as complete a botanical description as is reasonably possible.
- E. Page 4, line 2, applicant should provide the typical and observed bloom depth in order to provide as complete a botanical description as is reasonably possible.
- F. Page 4, line 4, applicant describes the stems; however the stems are not botanically part of the blooms, so description of them beneath this subheading is confusing and inappropriate. Applicant is requested to move the description of the stems to a more appropriate location of the Specification. Applicant is further requested to provide the stem diameter and color with reference to the employed color chart in order to provide as complete a botanical description as is reasonably possible.

G. Page 4, lines 20-31, applicant should provide more information about the petals and petaloids of the claimed plant; set forth the typical and observed petal and petaloid length and diameter in order to provide as complete a botanical description as is reasonably possible.

H. Page 5, line 23, applicant is requested to provide the leaf number in more substantive terms; the recitation of "Normal" is insufficient in this regard.

I. Page 6, line 10, applicant describes "Auricle shape, if present" as "none". Applicant should change this recitation to provide a shape or to state – none present – in order to lend clarity to the confusing recitation.

J. Page 6, line 14, applicant describes the "Pest Persistence" of the claimed plant. It is unclear what information applicant intends to convey by this recitation. Do pests avoid the plant? Does the plant lack pest resistance? Clarification is needed.

K. Page 6, lines 29 and 30, applicant is requested to provide the typical and observed number of prickles in substantive terms, if available.

The above listing may not be complete. Applicant should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

***Claim Rejection***

**35 USC § 112, 1st and 2nd Paragraphs**

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above.

***Conclusion***

No claim is allowed.

***References Cited***

The references cited are made of record to show the state of the art; the PBR documents provided are believed to disclose the claimed plant.

***Future Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy C. Haas whose telephone number is (571) 272-0976. The examiner can normally be reached on Monday through Friday 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is ((571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
W. C. Haas  
Patent Examiner  
Art Unit 1661